

## REMARKS

Reconsideration and allowance of this application are respectfully requested in light of the following remarks.

Anticipation is a strictly technical rejection. Because the Office Action cites three publications, in order to prevail on the 35 U.S.C. §102(b) rejection, each publication within itself and not in reliance on any other publication must teach the claimed invention in its entirety. Therefore, in each of the following arguments to overcome a rejection of claims based on anticipation, Applicants rely on the fact that it is well-settled that to establish anticipation requires a single prior art reference in which all of the same elements are found in exactly the same situation and united in the same way to perform the identical function. That is, “Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in a single prior art reference, there is no anticipation under 35 U.S.C. §102.” See, e.g., *Saf-Gard Products, Inc. v. Service, Inc.*, 532 F.2d 1266, 1290 (9<sup>th</sup> Cir. 1976), *cert. denied*, 429, U.S. 898 (1976); *Roberts v. Sears, Roebuck & co.*, 723 F.2d 1324, 1332 (7<sup>th</sup> Cir. 1983) (quoting *Illinois Tool Works, Inc. v. Sweetheart Plastics, Inc.*, 536 F.2d 1180, 1182-3 (7<sup>th</sup> cir.), *cert. dismissed*, 403 U.S. 942 (1971)).

Claims 1- 26 are rejected under 35 U.S.C. §102(b) as being anticipated by Celebro as taught in the articles “Tech Tapped To Protect Classified” NEXPO97, NAA Prestime (hereinafter NEXPO97), and article “GMTI To Giveaway Rolex Watch at NEXPO 2000”, Gannett Media Technologies International (hereinafter NEXPO2000) and Celebro.communiqué 1<sup>st</sup> quarter 2000.

### **Claims 1, 20, 25, and 26**

#### **The Office Action Position**

The Office Action alleges that claims 1, 25 and 26 are anticipated by Celebro (a company and not a reference) as taught in two cited references. Further, the Office Action alleges that Celebro teaches ad template means for specifying advertiser and publisher business rules (sic) and roles to control the preparation and administration of ads for publication, preparation and administration of ads, database for storing the ad templates, wherein ads are formatted for at least one ad delivery medium, a host system, data storage, a remote communications facilities (sic), a communication network, etc. (see NEXPO 97 page 4 par. 1 to page 5 par. 3, and 1<sup>st</sup> quarter 2000, pp 1-4).

The Office Action alleges that claim 20 is rejected as stated in claim 1.

Applicants Response

Applicants respectfully traverse.

At the outset Applicants note above that an anticipation rejection is a strictly technical rejection requiring a single prior art reference that teaches all the limitations recited by a claim. The Office Action is citing a company Celebro as teaching all the limitations by citing two articles, only one of which was authored by Celebro. Thus the Office Action is relying on two references by different authors as a basis for a 35 U.S.C. §102(b) anticipation rejection that is not the law with regard to anticipation, as pointed out above in REMARKS.

The cited references, of themselves, fail to teach one or more limitations of the claims and therefore cannot possibly anticipate as a matter of law.

Regarding the two references cited by the Office Action, neither of the cited references of NEXPO 97 page 4 par. 1 to page 5 par. 3” and “Celebro.communiqué 1<sup>st</sup> quarter 2000” teaches or suggests:

(1) ad template means for specifying company advertiser and ad publisher business rules to control preparation and administration of ads for publication (limitation i. of instant claim 1),

(2) ad template means for specifying at least one of company advertiser and ad publisher personnel roles to accomplish preparation and administration of ads for publication (limitation ii. of instant claim 1),

(3) ad templates means for preparation and administration of ads for publication by said roles according to said business rules ((limitation iii. of instant claim 1), and

(4) a database for storing said ad templates comprising company advertiser and ad publisher business rules, personnel roles and ads prepared and administered by said roles for publication according to said business roles (4<sup>th</sup> limitation of instant claim 1),

as recited by instant claim 1 and claims 2-19, 25 and 26 dependent therefrom. or the steps

(a) providing at least one ad template for specifying business rules and roles and for preparing

and administering ads;

(b) in said provided at least one ad template, specifying company advertiser and ad publisher business rules to control preparation and administration of ads for publication;

(c) said provided at least one ad template, specifying company advertiser and ad publisher personnel roles to accomplish preparation and administration of ads for publication;

(d) preparing and administering ads for publication by said specified roles using said provided at least one ad template according to said specified business rules for delivery by at least one delivery medium;

(e) storing said specified business rules and roles in the ad template in a database...

as recited by claim 20 and claims 21-24, dependent therefrom.

In view of the foregoing discussion, neither of the cited references of NEXPO97 and Celebro.communiqué, 1<sup>st</sup> quarter 2000 teaches or suggests any of the four limitations of instant claim 1 and the steps (a)-(e) of instant claim 20, and further Celebro is not the author of the cited NEXPO97 reference and therefore cannot teach its contents. Thus, based on the introductory remarks concerning the requirements for an anticipation rejection, there is no single reference cited by the Office Action that anticipates any of instant independent claims 1 and 20 nor claims 2-19, 25 and 26 dependent from claim 1 nor claims 21-24 dependent from claim 20 and the rejection thereof should be withdrawn. Claim 1 is allowable and claims 2-19, 25 and 26, dependent therefrom, are allowable for at least this reason. Claim 20 is allowable and claims 21-24, dependent therefrom, are allowable for at least this reason.

### **Claims 2-3**

#### **The Office Action Position**

The Office Action alleges that claims 2-4 are anticipated by Celebro (a company and not a reference) as taught in three cited references. Further, the Office Action alleges that Celebro teaches database accessible over the Internet (see NEXPO 97 page 4 par. 1-3 and NEXPO2000 page 1 par. 43 and 1<sup>st</sup> quarter 2000, pp 1-4).

#### **Applicants Response**

Applicants respectfully traverse.

At the outset Applicants note above that an anticipation rejection is a strictly technical

rejection requiring a single prior art reference, and not a single source of a plurality of references, that teaches all the limitations recited by a claim. The Office Action is citing a company, Celebro, as teaching all the limitations by citing three articles, only one of which was authored by Celebro. Thus the Office Action is relying on three references by different authors as a basis for a 35 U.S.C. §102(b) anticipation rejection which is not the law with regard to anticipation, as pointed out above.

**Claim 2 recites in pertinent part**

“... wherein said database is a least one of networked, distributed and replicated.”

and

**Claim 3 recites in pertinent part**

“ ...said ad template means for preparation comprises a Web browser ”

Regarding the three references cited by the Office Action, none of the cited references of NEXPO 97 page 4 par. 1-3 and NEXPO2000 page 1 par. 4 and Celebro.communiqué, 1<sup>st</sup> quarter 2000, pp 1-4, teaches or suggests

(1) wherein said database is a least one of networked, distributed and replicated (limitation of instant claim 2), and

(2) said ad template means for preparation comprises a Web browser (second limitation of instant claim 3),

as recited by instant claims 2 and 3.

NEXPO97 page 4 Par. 1-3 teaches only that advertiser send ads, with insertion orders and prices, to newspapers' ad databases and automated faxes acknowledge receipt and return ad proofs which would tend to indicate a non-electronic means for sending the information. No networked database is disclosed nor is a Web browser disclosed. NEXPO2000 discloses that Celebro.com accepts advertiser data via the Internet, places it into custom-designed ad templates, and electronically delivers those ads to newspaper-output ready-no proof required. Again, no networked database or Web browser is disclosed. Celebro.communiqué, 1<sup>st</sup> quarter 2000, pp 1-4 nowhere discloses any kind of database or Web browser.

In view of the foregoing discussion, none of the cited references of NEXPO 97 page 4 par. 1-3 and NEXPO2000 page 1 par. 4 and Celebro.communiqué, 1<sup>st</sup> quarter 2000, pp 1-4 teaches or suggests any of the limitation of instant claim 2 or the second limitation of instant claim 3 and

Celebro is not the author of the cited NEXPO97 reference and therefore cannot teach its contents. Thus, based on the introductory remarks concerning the requirements for an anticipation rejection, there is no single reference cited by the Office Action that anticipates instant claims 2 and 3 and the rejection should be withdrawn. Claims 2 and 3 are allowable and therefore have an independent basis for allowability.

### **Claims 5-19, 21-24**

#### **The Office Action Position**

With regard to claims 5-19, 21-24, the Office Action alleges that Celebro teaches attributes such as auto-pagination, specifying deadlines and schedules, color, size etc (see NEXPO 97 page 2-4 and 1<sup>st</sup> quarter 2000, pp 1-4). The Office Action further alleges that providing ad box template and ad master temple (sic) is inherent to Celebro's placement of ads in custom-designed ad templates.

#### **Applicants' Response**

Applicants respectfully traverse.

At the outset Applicants note above that an anticipation rejection is a strictly technical rejection requiring a single prior art reference, and not a single source of a plurality of references, that teaches all the limitations recited by a claim. The Office Action is citing a company Celebro as teaching all the limitations by citing two articles, only one of which was authored by Celebro. Thus the Office Action is relying on two references by different authors as a basis for a 35 U.S.C. §102(a) anticipation rejection which is not the law with regard to anticipation, as pointed out above.

There is no teaching in any of the cited references of Ad Box Template or Ad Master Template attributes and auto-pagination is taught as a business feature equivalent to classified order-entry (i.e., filling in an Ad Box Template to create an Ad Box instance) and tracking that performs processing of completed ads, e.g., squares off ads, vertically justifies text, inserts headers, adds fillers, generates indexes and specifies colors (NEXPO97 page 2 first par.). Auto-pagination is not taught as being associated with an Ad Box Template or Ad Master Template or any entry or component, respectively, thereof.

Claim 5 recites at least one Ad Box default template for preparing an Ad Box instance of an ad for an individual item and at least one Ad Master template for preparing a layout of an Ad Master instance defining a plurality of components comprising at least one Ad Box instance. The Office action admits that Celebro teaches auto-pagination. Contrary to the Office Action's allegation that

providing ad box template and ad master temple (sic) is inherent to Celebro's placement of ads in custom-designed ad templates, auto-pagination is not an attribute of an ad template but is another commonly used Ad placement technique that does not require an Ad Master Template or an Ad Master instance, as recited by claim 5. Auto-pagination is defined in the NEXPO97 reference (NEXPO97, page 1, par. 2 to page 3, par. 1), see, e.g.,

“Auto-pagination squares off ads, vertically justifies text, inserts headers, adds fillers, generates indexes and specifies colors.”(NEXPO97, page 3, par. 1)

“Perhaps the ultimate in classified pagination simplicity is a new service from Quantum 2000 of Irving, Texas. Newspapers can collect classified ads and send them via the Internet to Quantum 2000, which will paginate pages and return them to the sender within an hour or two.” (NEXPO97, page 2, par. 6 to top of page 3)

Federal Circuit decisions emphasize that an anticipatory inherent feature must be necessary and inevitable, not merely possible or probable, see, e.g., *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1363, 1373, 62 USPQ2d 1865 (Fed. Cir. 2002) (“anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation ...”). In view of the above discussion of auto-pagination for positioning ads, an Ad Master Template for layout of Ad Boxes therein is neither necessary nor inevitable in Celebro's placement of ads and further, as admitted by the Office Action, Celebro teaches auto-pagination for placement of ads and does not teach an Ad Master Template for this purpose.

Further, instant claims 5 and 21 (and claims 6-19 and 22-24, respectively dependent therefrom) recite a limitation of a status for indicating a stage of preparation and administration for both Ad Box and Ad Master instances, which is nowhere taught or suggested by any of the cited references.

With further regard to claims 6-19 and method claims 21-24, the Office Action provided no single prior art reference in which all of the same elements are found in exactly the same situation and united in the same way to perform the identical function as recited by each of these claims and as required for an anticipation rejection (see above REMARKS). The Office Action makes a blanket statement that Celebro teaches attributes such as auto-pagination, specifying deadlines and schedules, color, size etc. . However, as discussed above it is the NEXPO97 reference, not authored by Celebro, that teaches that auto-pagination squares off ads, vertically justifies text, inserts headers,

adds fillers, generates indexes and specifies colors, and the NEXPO97 reference is not teaching that Celebro offers auto-pagination or any of these 'attributes' as alleged by the Office Action. In fact, nowhere in any of the cited references is there a teaching by Celebro of attributes such as auto-pagination, specifying deadlines (instant claim 7) and schedules, color (instant claims 8 and 9), size (instant claim 8), etc. For a further example, claims 6 (dependent on claim 1) and 21 (dependent on claim 20) require specifying in the Ad Box Template and Ad Master Template themselves business rules for controlling entries made to an Ad Box instance and components placed in an Ad Master instance whereas the cited references teach that Celebro offers a fixed ad template that does not provide any means for specification of business rules to control entries made therein. As admitted by the Office Action Celebro does not teach an Ad Master Template and as argued above an Ad Master Template is not inherent in Celebro's placement of ads since placement can be accomplished by auto-pagination.

The references cited by the Office Action nowhere teach ad template means for specifying a plurality of company advertiser and publisher roles for preparation and administration of ads (claims 1 and 20) each of said plurality being assumable by at least one of company advertiser personnel and ad publisher personnel and at least one role being associated with each Ad Box Template and Ad Master Template (instant claims 10 and 23). In addition the references cited by the Office Action nowhere teach or suggest a plurality of roles each of which performs at least one of (1) creation, editing and database storing of Ad Box default templates and Ad Master templates and associated business rules and (2) creation, editing, setting status and database storing of instances of Ad Box templates according to the associated business rules, (3) creation, editing, sending to publisher, setting status and database storing of Ad Master instances by retrieving stored Ad box instances and laying them out in Ad Master instances, according to associated business rules, and (4) retrieval from the database, review, rejection, approval, sending to print and setting status of Ad Master instances (instant claims 11, 12 and 24).

Finally, none of the cited references teaches or suggests the subject matter of claim 13-19:

- (a) a component of an Ad Master Template comprises at least one filler box comprising a plurality of pre-determined entries (instant claim 13);
- (b) an Ad Box Template comprises at least one required entry (instant claim 14);
- (c) each of the plurality of entries of an Ad Box Template is selected from lead line,

image, audio, video, automation, geographic location display, signal (sig) line, and ad body text (instant claim 15);

- (d) the plurality of entries of an Ad Box Template further comprises at least one optional entry (instant claims 16 and 18); and
- (e) the optional entry of an Ad Box Template comprises banner, first line of company data, second line of company data and dollar amount (instant claims 17 and 19).

Therefore, in view of the foregoing discussions, each of the cited references of NEXPO 97 pages 2-4 and Celebro.communiqué, 1<sup>st</sup> quarter 2000, pp 1-4 , neither teach nor suggest all of the limitations of instant claims 5-19 and 21-24 and Celebro is not the author of the cited NEXPO97 reference and therefore cannot teach its contents. Thus, based on the introductory remarks concerning the requirements for an anticipation rejection, there is no single reference cited in the Office Action that anticipates instant claims 5-19 and 21-24 and the rejection should be withdrawn. Claims 5-19 and 21-24 are allowable and therefore have an independent basis for allowability.

#### Conclusion

For at least the above reasons, it is respectfully submitted that the present invention is in condition for allowance and a Notice of Allowance is respectfully requested.

Respectfully submitted,



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